

said electric motor[.];

a motorized head for providing a base for the blade receiving means, and

a plurality of interchangeable blade elements, each said blade element capable of attaching, in a removable manner, to said blade receiving means.

A2
2.(Once Amended) The electric knife of Claim 1, wherein said handle further

comprises:

a blade receiving slot, said blade receiving slot for accepting and storing any said blade elements not being attached to said blade [receiveing] receiving means; and

a locking mechanism, said locking [mechansim] mechanism for securely gripping any said [blades] blade elements within said blade receiving slot until released.

REMARKS

Reconsideration of the application as amended is respectfully requested.

The examiner respectfully rejected Claim 1 under 35 U.S.C. 102(b) as being anticipated by Torbet. Torbet teaches a light weight, hand-holdable, cordless and rechargeable appliance having a plurality of blade-like components for slicing, peeling and the like.

However, unlike the present invention, Torbet fails to utilize a blade receiving slot in the handle for storing a plurality of blade elements when they are not attached to the blade receiving slot/locking mechanism.

In addition, when a user desires to change blades, Torbet requires a user to release the power-delivering switch and pull on the blade, whereupon the detent releases the blade. In contrast, the present invention utilizes a blade release button in communication with blade release linkage for releasing a blade from the blade receiving slot/locking mechanism. Torbet requires a user to undergo unnecessary difficulty in removing a blade from a detent, thereby putting the user more at risk of being injured. In short, Torbet unnecessarily requires excessive handling of a blade, thereby increasing the user's risk of injury.

not claimed

Accordingly, because of the differences that exist between Torbet and the present invention, it is felt that rejection under 35 U.S.C. 102(b) is inappropriate.

The examiner respectfully rejected Claims 2 and 3 under 35 U.S.C. 103(a) as being unpatentable over Torbet in view of Jeffcoat.

The differences that exist between Torbet and the present invention have been stated above. Jeffcoat teaches an ergonomically-designed, multipurpose tool including a handle, a blade with a shank and a tip, and a fastener for attaching the handle to the shank. The handle may include a compartment for storing one or more additional instruments for use therewith.

However, there are numerous differences that exist between Jeffcoat and the present invention. Unlike Jeffcoat, the present invention is a cordless electric knife with a reciprocating mechanism for cutting a serrating.

Additionally, Jeffcoat fails to utilize a motor, a gear box, a power switch, a knife release button, and a knife release linkage.

Furthermore, unlike the present invention, Jeffcoat was designed such that in order to actuate skinning cuts, the user must grasp the handle and *pivot his wrist* to rotate thereby producing long, controlled strokes.

Moreover, there was no suggestion or motivation by either the Jeffcoat or the Torbet reference to combine a reciprocating electric knife having a handle with a compartment formed therein to facilitate the storing of additional blade elements to produce the claimed invention.

Based upon the above clarifications and limitations, it is felt that the differences between the present invention and these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is inappropriate.

However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, “Monday Morning Quarter Backing is quite improper when resolving the question of obviousness.” Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

“[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification.”
(Emphasis added). In re Gordon, 221 USPQ 1125, 1127

(Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features of the present invention, including the cordless, electric, reciprocating knife having a handle with a blade storage compartment. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The Examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC) 1988.

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC) 1986;

In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC) 1988.

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,

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